

**REMARKS**

Claim 56 has been amended to change "agent" to --clay--. Support for this amendment exists, *inter alia*, in the examples.

New claims 57 and 58 have been added. These claims correspond to claims 23 and 43, except that they do not contain the requirement that "n = 0." Support for these new claims exists throughout the present specification, note, for example, col. 2, lines 33-63.

New claims 59-78 have also been added. New claims 59 and 78 correspond to claim 1 except that the phrase "from 10% to 90% of at least one silicone oil" has been replaced with --at least one silicone-containing component--. Support for this amendment exists throughout the specification, particularly in the examples which disclose compositions containing several different silicone-containing components. Claim 78 also requires the presence of at least one gelling agent.

Claim 33 has been canceled.

Claims 1-32 and 34-78 are currently pending.

Initially, Applicants would like to thank Examiner Venkat for her indication that original claims 1-17 are in condition for allowance.

The Office Action rejected 18-56 under 35 U.S.C. § 112, first paragraph, asserting that the claims and specification as written do not satisfy the written description requirement. Specifically, the Office Action asserted that no support exists in the specification for (1) "silicone-containing resin" (claim 33); (2) "n = 0" (claims 23 and 43); and (3) "volatile oil." In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

Claim 33 has been canceled. Accordingly, Applicants respectfully submit that the rejection based upon the phrase "silicone-containing resin" has been rendered moot and should be withdrawn.

Regarding the § 112 rejection based upon the phrase “ $n = 0$ ,” the present specification states that “ $n$  and  $p$  are chosen so as to give the silicone gum a viscosity preferably greater than 100,000 mPa.s, and more preferably greater than 500,000 mPa.s. In general,  $n$  and  $p$  may have values preferably ranging from 0 to 5000, and more preferably ranging from 0 to 3000.” (Col. 2, lines 34-38 of the ‘297 patent)(emphasis added). Clearly,  $n$  can be equal to 0 based on this disclosure alone.

Moreover, the present specification states that “ $p = 0$ .” (Col. 2, lines 43, 66, 51 and 56 of the ‘297 patent). Because the present specification states that the range for  $n$  and  $p$  is the same (0-5000) and because the present specification expressly states that  $p = 0$ , it follows that  $n$  can be equal to 0 as well.

In view of the above, Applicants respectfully request reconsideration and withdrawal of this §112 rejection.<sup>1</sup>

Regarding the § 112 rejection based upon the phrase “volatile oil,” the fundamental inquiry in determining whether the phrase “volatile oil” is supported by the present specification is whether one skilled in the art would be led to “volatile oils” as a group by Applicants’ disclosure, or whether he would be led to merely volatile silicone oils. See, MPEP § 2163. Applicants respectfully submit that in view of the disclosure in the present specification, one skilled in the art would be led to volatile oils as a group, not merely volatile silicone oils.

Submitted herewith at Tab A is a copy of PCT application publication no. 96/19185. This PCT application claims priority from a U.S. patent application filed December 21, 1994. Given its proximity in time to the filing of the present specification, Applicants respectfully

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<sup>1</sup> Applicants also note that because new claims 57 and 58 do not contain the phrase “ $n=0$ ,” this rejection cannot apply to these new claims.

submit that the disclosure in this PCT application reflects how one skilled in the art would have interpreted the disclosure in the present specification at the time of its filing.

The PCT application discloses lip compositions containing dimethicone oils. The compositions can optionally contain volatile oils. (Pages 4-5). Significantly, the PCT application indicates that either volatile hydrocarbon oils such as isododecane or volatile silicone oils such as cyclomethicone can be combined interchangeably in the disclosed compositions containing dimethicone oil. (Page 5). Although this document does not relate to dimethicone gum and although it states that volatile oils are merely optional ingredients for possible inclusion in the disclosed compositions, the PCT reference shows that, from the perspective of one skilled in the art at the time of the present invention, volatile oils could be interchanged with dimethicone oils, if desired.

The present specification states that “[t]he invention is directed to anhydrous and water-resistant make-up compositions comprising, *inter alia*, at least one silicone gum.” (Col. 1, lines 8-10). Thus, on its most basic level, the present invention relates to compositions, particularly cosmetic compositions, containing a silicone gum such as dimethicone gum, as well as to the beneficial properties associated with such compositions. The present specification also states that oil should be present in the invention compositions, and exemplifies compositions containing both silicone and non-silicone oils, and both volatile and non-volatile oils.<sup>2</sup>

As demonstrated by the PCT reference discussed above which shows that volatile oils can be combined interchangeably with dimethicone oils, one skilled in the art, provided with

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<sup>2</sup> For example, example 1 contains “Bentone gel [sic IPM],” which is a commercial product containing isopropyl myristate, a non-volatile, non-silicone oil. (See, Tab B). Similarly, example 5 contains, among other non-silicone oily ingredients, C12-15 alkyl benzoate and jojoba oil, which are both non-volatile, non-silicone oils.

the present specification which discloses compositions containing silicone gum and several different types of oils,<sup>3</sup> would have been led by the present specification to combine silicone gum with interchangeable volatile oils as a group, not merely with volatile silicone oils.

That the present specification focuses on volatile silicone oils does not alter this conclusion. Volatile silicone oils are, first and foremost, volatile oils. Thus, even those portions of the present specification which disclose compositions containing both silicone gum and volatile silicone oil actually disclose compositions containing both silicone gum and volatile oil. Accordingly, Applicants' disclosure of volatile silicone oil, by itself, is sufficient to support the phrase "volatile oil." *See, In re Herschler*, 521 F.2d 693, 697 (CCPA 1979)(where the Court found that the disclosure of a single corticosteroid in DMSO supported a claim directed to a "physiologically active steroid" in DMSO).

In view of the above, Applicants respectfully request reconsideration and withdrawal of this rejection under § 112.

Finally, the Office Action objected to the reissue oath/declaration filed in this case on the basis that Applicants did not state their specific preferred embodiment. Applicants respectfully submit that such a statement is not required. As stated in MPEP 1414 at page 1400-23 "[t]he corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration." Even in view of this, paragraphs 9, 10 and 11 of the Declaration state that the patent is partly inoperative because patentee claimed less than they had a right to claim, that the claims omit preferred embodiments, and that *to correct this error* claims 18-56 were added. Thus, the Declaration is proper.

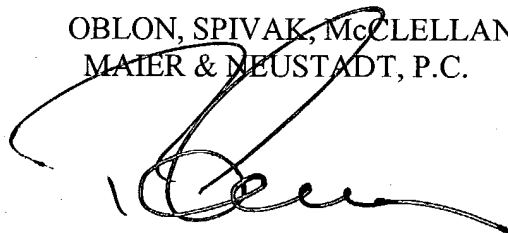
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<sup>3</sup> See also, col. 4, lines 12-13 of the present specification for additional disclosure related to non-silicone oils.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Treanor', with a large, sweeping initial 'T'.

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